

**REMARKS**

This paper is submitted in reply to the Office Action dated December 30, 2003, within the three-month period for response. Reconsideration and allowance of all pending claims are respectfully requested.

In the subject Office Action, claim 32 was objected to by the Examiner. In addition claims 1-2, 5-8, 13-18, 20-22, 25-31, and 33-36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,020,884 to MacNaughton et al. in view of U.S. Patent No. 6,240,443 to Suzuki et al., claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of Suzuki et al. in further view of "Chat Comp: Lobby," Yahoo!, <http://chat.yahoo.com> downloaded 11/18/98 (hereinafter Yahoo), and claims 9, and 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over MacNaughton et al. in view of U.S. Patent No. 6,366,947 to Kavner. The Examiner did indicate, however, that claims 19 and 32 were directed to patentable subject matter.

Applicants respectfully traverse the Examiner's rejections to the extent that they are maintained. Applicants have now amended claims 1, 7 and 25 to clarify that the recited saved user list is "user-editable". Applicants respectfully submit that no new matter is being added by the above amendments, as the amendments are fully supported in the specification, drawings and claims as originally filed.

Now turning to the subject Office Action and specifically to the rejections of claims 1, 7 and 25, the Examiner maintained the original rejections based upon the combination of MacNaughton et al. and Suzuki et al., essentially arguing that Suzuki et al. teaches adding and removing users from a user list in response to user input. Specifically, the Examiner notes, in ¶60 of the subject Office Action, that a user entering a different URL where a second user was not currently viewing the different URL, but a third user was, would effectively remove the second user from the list and add the third user to the list. The Examiner further noted that, were Applicants to be more specific

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about the "user-editable" nature of the recited list, the claims would possibly overcome the prior art.

While Applicants do not necessarily concur with the Examiner's interpretation of Suzuki et al., Applicants have nonetheless amended claims 1, 7 and 25 to now recite that the saved user list is "user-editable". As the Examiner has acknowledged, this feature is not disclosed in Suzuki et al. or the other prior art of record.

As noted previously, the recited user-editable saved user list recited in claims 1, 7 and 25 provides the ability for a user to maintain a personalized user list. As such, a user is able to select which users he or she will be notified about as viewing the same document. Such an implementation provides significant benefits over the centrally-managed lists of Suzuki et al., particularly where hundreds or thousands of users are being tracked. Consider where a particular user is viewing the same document as 100 other users, of which only two or three were of interest to the user. With the Suzuki et al. system, the user would be notified of all 100 other users. In contrast, with the invention recited in claim 1, that user would be able to limit his or her saved user list to only those other users the user cared to be notified about.

Providing the ability to add or remove a user to or from a user-editable saved user list, as recited in claim 1, provides a unique and unexpected advantage that is not suggested by either MacNaughton et al. or Suzuki et al. Claims 1, 7 and 25 are therefore non-obvious over this combination of references. Reconsideration and allowance of claims 1, 7 and 25, and of claims 2-6, 8, 13-18, 20-22, and 26-36 which depend therefrom, are therefore respectfully requested.

Next, with respect to independent claim 9, this claim generally recites a method of providing access to hypertext documents in a multi-user computer environment, which includes *inter alia* maintaining a navigation history for a second user, where the navigation history includes a set of hypertext documents previously accessed by the

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second user. The claim also recites the step of notifying the first user of the set of hypertext documents in the navigation history for the second user.

In rejecting claim 9, the Examiner admits that MacNaughton et al. does not disclose either maintaining a navigation history for a user, or notifying one user of the documents in the navigation history for another user. Instead, the Examiner relies on Kavner to disclose a table of navigation history, citing col. 5, line 53- col. 6, line 6 and col. 17, lines 3-30.

The cited passages in Kavner, however, disclose only an intelligent fetch operation that attempts to prefetch, on behalf of a user, any web pages in the navigation history for that user.

Claim 9, on the other hand, is essentially directed to notifying one user of the contents of the navigation history for a different user.

Neither MacNaughton et al., nor Kavner, discloses the ability to notify one user of the documents in the navigation history for a different user, as is recited in claim 9. Accordingly, the combination of MacNaughton et al. and Kavner falls short of teaching each and every feature of claim 9.

Moreover, Applicants respectfully submit that neither reference suggests to one of ordinary skill in the art the desirability of enabling a user to view information from the navigation history of another user. Short of any objective evidence of a motivation to modify MacNaughton et al. to provide such a capability, an obviousness rejection of claim 9 cannot be sustained. Applicants therefore respectfully submit that claim 9 is patentable over the combination of MacNaughton et al. and Kavner. Reconsideration and allowance of claim 9 are therefore respectfully requested.

Next, with respect to independent claim 11, this claim generally recites a method of providing access to hypertext documents in a multi-user computer environment, which includes *inter alia* maintaining a navigation history for a second user, where the navigation history includes a set of hypertext documents previously accessed by the

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second user. The claim also recites the step of displaying a first hypertext document to the first user, where the first hypertext document includes a hypertext link to a second hypertext document that is in the navigation history for the second user, and where displaying the first hypertext document includes displaying within the first hypertext document and in association with the hypertext link an indication that the second hypertext document is in the navigation history for the second user.

As with claim 9, the Examiner rejects claim 11 on the basis of MacNaughton et al. and Kavner, with the Examiner referencing claim 9 in the comments directed to claim 11. Applicants submit however that, as with claim 9, claim 11 is non-obvious over the combination of MacNaughton et al. and Kavner. As noted above, Kavner discloses, at the most, a navigation history for a user that is used in prefetching web pages on behalf of that same user. There is nothing in Kavner that discloses or suggests any notification to one user as to whether a particular document is in the navigation history for another user.

Moreover, it should be noted that claim 11 is specifically directed to the concept of displaying in association with a hypertext link in a displayed document an indication that the document referenced by that hypertext link is in the navigation history of a different user. The Examiner has not even addressed where this particular feature is disclosed in either MacNaughton et al. or Kavner, and Applicants can find no disclosure in either reference that is relevant to such a feature. Furthermore, Applicants can find nothing in either reference that would motivate one of ordinary skill in the art to modify MacNaughton et al. to provide this additional feature.

As such, Applicants respectfully submit that claim 11 is patentable over the combination of MacNaughton et al. and Kavner. Reconsideration and allowance of claim 11, and of claim 12 which depends therefrom, are therefore respectfully requested. Reconsideration and allowance of claim 11, and of claim 12 which depends therefrom, are therefore respectfully requested.

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In summary, Applicants respectfully submit that all pending claims are novel and non-obvious over the prior art of record. Reconsideration and allowance of all pending claims are therefore respectfully requested. If the Examiner has any questions regarding the foregoing, or which might otherwise further this case onto allowance, the Examiner may contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

30 MARCH 2004

Date

Respectfully submitted,



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